

REMARKS

I. Amendments

Claims 27-31 have been cancelled and new claims 38 and 39 have been added. This amendment adds no new matter to the specification. Support for the new claims may be found in the specification as originally filed.

A typographical error has been corrected in the specification.

No amendment of inventorship is necessitated by these amendments.

II. Request for Consideration of the First Preliminary Amendment

On December 12, 2001, Applicants submitted a Preliminary Amendment with the original specification. The Notice of Acceptance mailed June 7, 2002 indicates that Preliminary Amendments were received by the U.S. PTO, indicating that more than one Preliminary Amendment was received.

From the Examiner's remarks in the Office Action, it appears that the Second Preliminary Amendment (filed January 24, 2002) may have been reviewed, but not the entire first Preliminary Amendment. Since the First Preliminary Amendment includes several changes to the claims, Applicants respectfully request the Examiner's consideration and entry into the record of the entire First Preliminary Amendment. Should a copy of the First Preliminary Amendment not be in the Examiner's files, the Examiner is requested to contact Applicants' attorney for a copy.

III. Request for Consideration of a Third Supplemental Information Disclosure Statement

A third Supplemental Information Disclosure Statement accompanies this response. Applicants respectfully request consideration of the Statement.

IV. Discussion of the Objection to the Specification

The Examiner has objected to the specification for the use of the term “deydroacetic acid” on page 55 in the first paragraph. By this amendment, Applicants have corrected the typographical error by adding the missing letter “h”.

Therefore Applicants respectfully request withdrawal of the objection to the specification.

V. Discussion of the Rejection of Claims 2 and 24 under 35 U.S.C. Sec. 112, First Paragraph

Claims 2 and 24 have been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement in the recitation of “prodrugs”. Applicants respectfully traverse the rejection.

Applicants submit that the term is adequately enabled, as support for the term is found in the specification at page 51, line 19 – page 53, line 5.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claims 2 and 24.

VI. Discussion of the Rejection of Claims 26-31 and 36 under 35 U.S.C. Sec. 112, First Paragraph

Claims 26-31 and 36 have been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement in the recitation of “prevention”. Applicants respectfully traverse the rejection.

By this amendment, claims 27-31 have been cancelled, rendering the aspect of the rejection related to these claims moot. Moreover, neither claim 26 nor claim 36 contains the term “prevention”.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claims 26-31 and 36.

VII. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph

Claims 17-19, 23, 27-31, 35 and 36 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite in several different manners. Applicants respectfully traverse the rejection. Each aspect of the rejection will be discussed separately in the following paragraphs.

In the first aspect of the rejection, claims 17-19 have been rejected for reciting “alicyclic hydrocarbon” groups, as allegedly not having sufficient antecedent basis. Alicyclic is used to refer to any aliphatic compound that contains a ring of carbon atoms. Applicants believe that they have sufficient antecedent basis for this term. Since R³ may be an aliphatic hydrocarbon group as indicated in claim 1, and the specification defines aliphatic hydrocarbon groups on page 41, line 7 – 15 as including aliphatic straight-chain hydrocarbon groups and aliphatic cyclic hydrocarbon groups, there is proper antecedent basis.

In the second aspect of the rejection, the Examiner has indicated that some terms of claim 23 have been misspelled. However, the words pointed out by the Examiner were not misspelled in the original claims and not modified by amendment, so Applicants believe that the words are correct as shown in pending claim 23 in this response.

In the third aspect of the rejection, claims 27-31 have been objected to as substantial duplicates of claim 26. By this amendment, claims 27-31 have been cancelled, rendering this aspect of the rejection moot.

In the fourth aspect of the rejection, claims 27-31 and 36 have been rejected as allegedly vague use claims. By this amendment, claims 27-31 have been cancelled. As to claim 36, it is directed to antagonizing a CC chemokine receptor in a mammal. The Examiner has objected to the claim, stating that it is vague for not setting “forth any steps involved in determining which are the diseases capable of being mediated by a chemokine receptor”. Applicants respectfully submit that claim 36 is not vague, and request that the Examiner review the support for the claim found on page 74, line 11 – page 76, line 21 *inter alia* (wherein dosage is discussed). Furthermore, claims which recite methods for antagonizing CCR5 have been found to be patentable by the U.S. Patent and Trademark Office. The Examiner is respectfully requested to review claim 17 of U.S. Patent No. 6,268,354; claim 33 of U.S. Patent No. 6,172,061 and claim 13 of U.S. Patent No. 6,096,780 for some examples.

In the fifth aspect of the rejection, claim 35 has been rejected as allegedly vague in the recitation of “a protease inhibitor, a reverse transcriptase inhibitor or a combination thereof”. The phrase simply indicates that treatment can be made with a combination of:

a compound of claim 1 or a salt thereof with a protease inhibitor;
a compound of claim 1 or a salt thereof with a reverse transcriptase inhibitor or
a compound of claim 1 or a salt thereof with a protease inhibitor and a reverse transcriptase inhibitor.

Applicants do not believe the use of this phrase renders claim 35 vague.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection.

VIII. Discussion of the Rejection for Obviousness-Type Double Patenting over Shiraishi *et al.*

Claims 1, 3-23, 25 and 26 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Shiraishi *et al.* (U.S. Patent No. 6,166,006).

To advance the prosecution of the pending claims, a Terminal Disclaimer over the ‘006 patent accompanies this response.

Therefore Applicants respectfully request withdrawal of the rejection for obviousness-type double patenting over Shiraishi *et al.*

IX. Discussion of the Rejection for Obviousness-Type Double Patenting over Nishimura *et al.*

Claims 25-31 and 35-37 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Nishimura *et al.* (U.S. Patent No. 6,172,061).

To advance the prosecution of the pending claims, a Terminal Disclaimer over the ‘061 patent accompanies this response.

Therefore Applicants respectfully request withdrawal of the rejection for obviousness-type double patenting over Nishimura *et al.*

IX. Conclusion

Reconsideration of the claims and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

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